

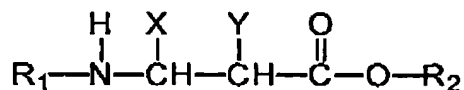
and R2 is hydrogen. Claims 1, 2, 6-8, 12-14 and 24-29 are readable thereon.

### REMARKS

#### *Restriction Requirement*

Restriction is proper only if the restricted claims are independent or patentably distinct and there is no serious burden placed on the Examiner if restriction is not required (MPEP §803). The burden is on the Examiner to provide reasons and/or examples to support any conclusion of patentable distinctness between the restricted claims (MPEP §803). Applicants respectfully traverse the restriction requirement on the grounds that the Examiner has not carried the burden of providing any reason and/or example to support the conclusion that the claims of the restricted groups are, in fact, distinct. Applicants further traverse the restriction requirement because there is clearly no additional burden on the Examiner if the restriction requirement is not made.

The Examiner has required the election of a single generic cyclic core structure having defined values for X and Y for Formula I:



Specifically, the Examiner states that "X and Y are combined together to form a saturated or unsaturated, substituted or unsubstituted, cycloalkyl or cycloalkenyl, homocyclic or heterocyclic" compound. The Examiner has further characterized these compounds as independent and/or patentably distinct for several reasons. For instance, the Examiner states that the compounds of Formula I lack a sufficient core (e.g., fixed) structure to elicit a common activity and that the compounds of Formula I encompass multiple compounds of variable chemical structures and/or physical/biological/chemical properties which are capable of separate manufacture and/or use.

However, Applicants submit that the reasons offered by the Examiner are insufficient to support a conclusion of patentable distinctness between the compounds of Formula I. For instance, the Examiner has provided no reasons or examples to show that there is, in fact, a lack of sufficient fixed core structure between the beta amino acids described by the compounds of Formula I. Further, the Examiner has provided no indication as to how the compounds of Formula I have different "physical/biological/chemical properties which are capable of separate manufacture and/or use." In other words, the Examiner has provided no sound scientific rationale that the beta amino acids of Formula I are independent and/or patentably distinct.

The Examiner goes on to state that Formula I represents compounds which are burdensome to search. Specifically, the Examiner states that the compounds of Formula I are drawn to diverse chemical structures which require different, non-divergent and separately burdensome manual/computer structures, classification and bibliographic searches; that the compounds of Formula I are unduly burdensome to examine together since different core structures resulting from X and Y selection will require different considerations, and the reference to one core generic or species therein will not be applicable as prior art against the different core structure compounds or species; and/or that the compounds of Formula I encompass separately classified compounds such as imidazoles, cyclopentanes, pyrrols, and pyrazines.

However, Applicants submit there is no additional burden on the Examiner if the restriction requirement is not made. For instance, the Examiner has provided no examples

or reasons as to why the compounds of Formula I require "different/nondivergent and separately burdensome manual/computer structure, classification and bibliographic searches." Further, the Examiner has provided no reasons or examples to show why the reference to one core generic or species will not be applicable as prior art against a different core structure. Thus, Applicants submit that there is no additional burden on the Examiner if restriction is not required.

*Election of Species Requirement*

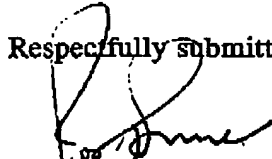
In the same fashion as a Restriction Requirement, an Election of Species Requirement is proper only if the restricted species are independent or patentably distinct and there is no serious burden placed on the Examiner if an election is not required (MPEP §803). The burden is on the Examiner to provide reasons and/or examples to support any conclusion of patentable distinctness between the restricted species (MPEP §803). Applicants respectfully traverse the Election of Species Requirement on the grounds that the Examiner has not carried the burden of providing any reasons and/or examples to support the conclusion that the species are, in fact, distinct.

Additionally, the Examiner has provided no reasons or examples to support the conclusion of patentable distinctness between the species recited in these claims. It is insufficient for the Examiner merely to identify mutually exclusive moieties and state that they are patentably distinct on that basis alone. The Examiner must supply some reason and/or examples to support the conclusion of patentable distinctness between the restricted species. Therefore, Applicants submit that the Election of Species Requirement is improper and should be withdrawn.

**CONCLUSION**

Applicants submit that the application is now ready for examination on the merits.  
Early notification of such action is earnestly solicited.

Respectfully submitted,

  
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